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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/645,376

08/21/2003

James A. Euchner

F-660

7462

7590

06/20/2006

Pitney Bowes Inc.
Intellectual Property and
Technology Law Department
35 Waterview Drive, P.O. Box 3000
Shelton, CT 06484

EXAMINER

FUREMAN, JARED

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,376

Applicant(s)

EUCHNER ET AL.

Examiner

Jared J. Fureman

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the appeal brief filed on 3/20/2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

Claims 1-28 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as Sansone at the time this invention was made, or was subject to a joint research agreement at the time this invention was made. However, reference Sansone additionally qualifies as prior art under another subsection of 35 U.S.C. 102, and therefore, is not disqualified as prior art under 35 U.S.C. 103(c).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

5. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon (US 6,701,304, previously cited) in view of Sansone (US 6,574,000, previously cited) and Abello (US 2005/0260021 A1).

Leon teaches an apparatus (authentication system 500, figure 5) and method comprising: reading means (ZIP reader 510 and symbology reader 520) for reading an indicia (410, 412, 414, 418, 416, figure 4) on a label (indicium 400, figure 4); detecting means (marking detector 530, figure 5) for detecting at least one ink physical characteristic (the use of invisible and/or fluorescent ink, taggants in the ink, etc., see column 13 lines 28-33) of the indicia to generate second ink characteristic data; and processing means (computer 540, figure 5), coupled to the reading means and to the detecting means, for comparing the second ink physical characteristic data with the first data (see column 13, lines 34-42); wherein data is included in the first indicia in encrypted form (a digital signature imprinted on the postage label), and the reading means includes means for decrypting the encrypted first ink characteristic data (see column 13, lines 36-39); wherein the at least one ink characteristic detected by the detecting means includes at least one of: (a) a color of at least a portion of the indicia, (b) a spectral characteristic of the indicia, (c) a visible light absorption characteristic of the indicia, (d) a visible light reflectance characteristic of the indicia, (e) an infra-red absorption characteristic of the indicia, (f) an infra-red luminescence characteristic of the indicia, and (g) a visible luminescence characteristic of the indicia (since the marking detector 530 can detect the use of invisible ink, fluorescent ink, and taggants in the ink, the characteristics detected by the marking detector 530 will include spectral characteristics, infra-red absorption characteristics, luminescence characteristics, etc.); wherein the detecting means detects respective colors of a plurality of different portions of the indicia (the use of visible, invisible, fluorescent inks suggests respective colors of

Art Unit: 2876

a plurality of different portions); a print element (printer 154, figure 2A) for applying ink to a substrate to form an indicia; and processing means (processor 210, figure 2A) coupled to the print element for causing the print element to print at least one symbol (see figure 4) as part of the indicia; wherein the indicia includes a plurality of panels (see figure 4); wherein at least two of the panels are of different colors (the use of visible ink, invisible ink, fluorescent ink and taggants in the ink suggests different colors); wherein the processing means causes the print element to print the ink characteristic data in encrypted form (see column 5 lines 15-16) (also see figures 2A, 3-5, column 4 line 38 - column 5 line 25, column 12 line 30 - column 53).

Leon fails to specifically teach reading first ink data from an indicia; the at least one symbol including ink data.

Sansone teaches an apparatus and method comprising: reading means (indicia reader 37, figure 3) for reading first ink data from an indicia (code 22 includes ink characteristic data, such as the type of ink that was used to print indicia 21, see column 4 lines 22-25); the at least one symbol including ink data (the type of ink used to print the indicia 21) (also see figures 2, 3, column 3 line 50 - column 4 line 32, column 5 line 32 - column 6 line 5). Sansone also teaches an apparatus and method comprising: a print element (not shown, but necessarily present, for printing postal indicia 21 on envelope 12, see figure 2 and column 3 lines 63-65) for applying ink (the ink used to print postal indicia 21) to a substrate (envelope 12) to form an indicia (indicia 21); and

Art Unit: 2876

processing means (not shown, but necessarily present) coupled to the print element for causing the print element to print at least one symbol (22) as part of the indicia, the at least one symbol including ink data (the type of ink used to print indicia 21, see column 4 lines 22-25) wherein the indicia includes a plurality of panels (as shown in figure 2, indicia 21 includes a plurality of panels) (also see figure 2 and column 3 line 50 - column 4 line 32).

In view of Sansone's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the apparatus and method as taught by Leon, reading first ink physical characteristic data from an indicia; the at least one symbol including ink physical characteristic data that is indicative of a physical characteristic of the ink; in order to allow the reader to easily identify the expected characteristics of the ink(s) for comparison to the detected characteristics, thereby allowing the greater authentication capabilities.

Leon as modified by Sansone fails to specifically teach the ink data being ink physical characteristic data; the at least one symbol including ink physical characteristic data that is indicative of a physical characteristic of the ink; wherein the ink characteristic data is indicative of a color of the ink; the ink characteristic data is indicative of respective colors of the plurality of panels; wherein at least two of the panels are of different colors; wherein the ink characteristic data is indicative of at least

one spectral characteristic of the ink; wherein the ink characteristic data is indicative of at least one luminescence characteristic of the ink.

Abello teaches the use of indicia (a letter, for example, see paragraph 80) to identify ink physical characteristic data (the letter indicates the color of the ink, see paragraph 80); at least one symbol including ink physical characteristic data (the letter indicates the color of the ink, which is a physical characteristic of the ink, see paragraph 80); wherein the ink characteristic data is indicative of a color of the ink (the letter indicates the color of the ink, see paragraph 80); the ink characteristic data is indicative of respective colors of a plurality of colors; wherein the ink characteristic data is indicative of at least one spectral characteristic of the ink (the color of the ink is indicative of a spectral characteristic of the ink, the spectral characteristics of that color); wherein the ink characteristic data is indicative of at least one luminescence characteristic of the ink (the color of the ink is also indicative of at least some luminescent characteristics of that particular color of ink).

In view of Abello's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the apparatus and method as taught by Leon as modified by Sansone, the ink data being ink physical characteristic data; the at least one symbol including ink physical characteristic data that is indicative of a physical characteristic of the ink; wherein the ink characteristic data is indicative of a color of the ink; the ink characteristic data is indicative of respective colors of the

plurality of panels; wherein at least two of the panels are of different colors; wherein the ink characteristic data is indicative of at least one spectral characteristic of the ink; wherein the ink characteristic data is indicative of at least one luminescence characteristic of the ink; in order to use the indicia to directly indicate at least some physical characteristic of the ink, thereby helping to alleviate the need to look-up or otherwise further determine ink physical characteristic data based on indicia of the type of ink (as taught by Sansone, for example), thereby creating a more efficient system.

Response to Arguments

6. Applicant's arguments (that Sansone fails to teach the indicia being indicative of at least one physical characteristic of the ink), see page 13, of the appeal brief filed 3/20/2006, with respect to the rejection(s) of claim(s) 1-28 under 102(a,e) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Leon as modified by Sansone and Abello. As discussed above, Abello teaches the use of indicia to indicate a physical characteristic of ink (the letter indicates the color of the ink, the color of the ink being a physical characteristic, see paragraph 80).

In addition, regarding claims 15-21, it appears as though the claim language "for applying ink to a substrate to form an indicia" (see line 2, of claim 15) and "for causing the print element to print at least one symbol as part of the indicia, the at least one symbol including ink physical characteristic data that is indicative of a physical

Art Unit: 2876

characteristic of the ink." (see lines 3-5, of claim 15), represents a functional limitation of the print element and processing means. Applicants are reminded that functional language (as recited in claims 15-21) does not define the invention over the prior art, when the prior art discloses the claimed structural limitations and is capable of performing the recited function (see MPEP 2114). The limitation of the symbol including ink physical characteristic data merely represents the type of data that is encoded by the indicia/symbol. Applicants have not shown that the symbol including ink physical characteristic data requires a structural difference between the claimed apparatus and any prior art apparatus containing a print element and processing means coupled to the print element. Thus, it appears as though any generic apparatus having a print element for applying ink to a substrate to form an indicia and processing means coupled to the print element for causing the print element to print at least one symbol as part of the indicia would meet the claimed structural limitations and would be capable of performing the limitations of the function language. Would applicants please explain how the functional language requires a structural difference between the claimed apparatus and the prior art?

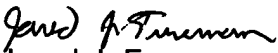
Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jones et al (US 2005/0088499 A1) teaches the use of symbols/indicia to indicate a physical characteristic of ink (see paragraph 41).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (571) 272-2391. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jared J. Fureman
Primary Examiner
Art Unit 2876

June 12, 2006


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800